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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,613	10/03/2003	Jamie Garroch	NEC P15578	9435
27667	7590	05/17/2006		
HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			EXAMINER SANTIAGO CORDERO, MARIVELISSE	
			ART UNIT 2617	PAPER NUMBER

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/678,613	Applicant(s) GARROCH, JAMIE	
	Examiner Marivelisse Santiago-Cordero	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Art Unit – Location***

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.
2. Claims 1-2, 2-4, and 8-9 are pending.

### ***Response to Arguments***

3. Applicant's arguments filed on 4/24/06 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant argues that the primary reference Ishihara neither discloses nor suggests a user movable cursor visible on the front face of the device movable by the user by a touch pad provided on the rear face of the device. The Examiner respectfully disagrees. Ishihara's Fig. 5 reference 55 shows the cursor visible on the front face of the device. In addition, paragraph [0050] discloses the cursor movable by the user by a touch pad provided on the rear face of the device. Note that in Ishihara, when the user wants to perform actuation of one of the functions (e.g., functions 1 through 4 in Fig. 5), the user presses the touch pad provided on the rear face of the device (Fig. 6, reference 37) and the cursor is moved to the location of desired selections (paragraph [0055]). Accordingly, Ishihara discloses a user movable cursor visible on the front face of the device movable by the user by a touch pad provided on the rear face of the device. The term "moving" is broadly claimed; therefore, broadly interpreted.

Applicant argues that Karkkainen does not supply the missing teachings to Ishihara and that the claims cannot be said to be obvious (Remarks: page 4, 3<sup>rd</sup> paragraph). The Examiner respectfully disagrees for the reasons stated above, where Ishihara does disclose a user movable cursor visible on the front face of the device movable by the user by a touch pad provided on the rear face of the device. In addition, Karkkainen is used for the incorporation of a selection bar to indicate which function presently highlighted and available for selection, being obvious for the advantages of providing additional information for the user, in case he/she does not know the meaning of icons and to enable a quicker understanding of the selected menu items (Karkkainen: col. 3, lines 57-62); thus, user-friendlier.

Regarding claim 9, Applicant argues that Chia-Ying is a portable computer rather than a hand-held device and that it does not teach or suggest a touch pad on the back of the device (Remarks: page 5, lines 2-4). In response, the recitation “hand-held device” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In addition, the rejection is based on a combination of references, not in Chia-Ying alone. The combination does teach a hand held device with a touch pad on the rear face of the device (see primary reference: Ishihara) in which a selection button also allows a user to execute “click” and “drag-lock” operations (see Chia-Ying).

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Applicant further argues that no combination of Ishihara, Karkkainen, and Chia-Ying could be said to achieve or render obvious claim 1 or claim 9. The Examiner respectfully disagrees. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, from the rejection previously submitted in Office Action dated 2/21/06 and the rejection following herein below, it is clear that the combination of Ishihara, Karkkainen, and Chia-Ying achieve and render obvious claim claim 9 for the advantage of allowing the user to arrange and/or sort selections based on user's preferences, thus, user-friendlier. Furthermore, the combination would allow the portable hand held device to the perform operations as known from the functions of previously available operating systems and application programs used with conventional computer systems.

4. Accordingly, for the reasons stated above, this Action is made FINAL.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishihara et al. (hereinafter "Ishihara"; JP 2002077357A; also see Electronic Translation) in view of Karkkainen et al. (hereinafter "Karkkainen"; Patent No.: 6,600,936; cited in form PTO-892, paper no. 20050928).

Regarding claim 1, Ishihara discloses a portable hand held electronic device (Abstract; Fig. 7) comprising a display (Abstract; Fig. 7, reference 33; Fig. 10, reference 71) having a user controlled cursor (Fig. 5, reference 55, paragraph [0050]) visible on a front face of the device (Abstract; Fig. 5) on which selectable functions may be displayed (Abstract; Figs. 5, 8, 16; paragraph [0058]), highlighted (Figs. 5 and 16; paragraph [0058]), and selected by a user (Abstract), and a touch pad provided on a rear face of the device for a user to select the functions by moving the cursor (Abstract; Figs. 1, 6, 8-9, and 11, references 37 and 72; paragraph [0050]), said device further comprising a separate keypad (Figs. 10-11, reference 76) hingedly coupled to the front face of the device (Figs. 10-11, reference 79).

Ishihara fails to disclose a selection bar to indicate which function is presently highlighted and available for selection.

However, Karkkainen discloses a portable hand held electronic device comprising a display on a front face of the device (Fig. 1) on which selectable functions may be displayed (Fig. 1), highlighted (col. 2, lines 30-36), and selected by a user (col. 5, lines 16-19), and a selection bar to indicate which function is presently highlighted and available for selection (Figs. 5-7, reference F).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to indicate the function presently highlighted and available for selection of Ishihara by a selection bar as suggested by Karkkainen.

One of ordinary skill in this art would have been motivated to indicate the function presently highlighted and available for selection by a selection bar because additional information is provided for the user, in case he/she does not know the meaning of icons very well and to enable a quicker understanding of the selected menu items (Karkkainen: col. 3, lines 57-62), thus, user-friendlier.

Regarding claim 2, in the obvious combination, Ishihara discloses in which the touch pad is positioned substantially directly behind the display (Figs. 10-11).

Regarding claim 4, in the obvious combination, Ishihara discloses in which the function, which is available for selection, is highlighted (paragraph [0058]).

Regarding claim 5, in the obvious combination, Ishihara discloses in which the touch pad has the same dimensions as the display (Figs. 10-11; paragraph [0063]).

Regarding claim 8, in the obvious combination, Ishihara discloses and further including software-controlled circuitry (Fig. 4; paragraphs [0044]-[0051]), which translates a point of contact on the touch pad to a corresponding portion on the display (paragraphs [0044]-[0051]).

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishihara in combination with Karkkainen as applied to claim 1 above, and further in view of Chia-Ying et al. (hereinafter "Chia-Ying"; cited in form PTO-892, paper no. 20050928).

Regarding claim 9, Ishihara in combination with Karkkainen disclose a portable electronic device according to claim 1 (see above) and a selection button (Karkkainen: Fig. 1,

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reference 5), which would have been obvious to one of ordinary skill in this art at the time the invention was made to incorporate, the motivation being for entering a respective menu item or function (Karkkainen: col. 5, lines 10-11). Ishihara in combination with Karkkainen fails to disclose in which the selection button also allows a user to execute 'click' and 'drag-lock' operations.

However, Chia-Ying discloses a portable electronic device in which a selection button also allows a user to execute 'click' and 'drag-lock' operations (col. 6, lines 49-57).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to execute in the selection button of Ishihara in combination with Karkkainen 'click' and 'drag-lock' operations as suggested by Chia-Ying.

One of ordinary skill in this art would have been motivated to execute in the selection button 'click' and 'drag-lock' operations because it would allow the user to arrange and/or sort the selection based on user's preferences, thus, user-friendlier.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pihlaja (Patent No.: 7,009,599) discloses a portable hand-held electronic device having a display on a front face and a touch pad on a rear face and Kato et al. (Patent No.: US 6,297,795) discloses a portable hand held electronic device incorporating a selection button allowing a user to execute "click" and "drag-lock" operations.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marivelisse Santiago-Cordero whose telephone number is (571) 272-7839. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSC 5/15/06

MSC



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